

**REMARKS**

Applicants thank the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this amendment.

**Status of the Claims**

Claims 1-25 are pending in the present application. Claims 1, 4, 8, 13 and 15 are independent claims. Claims 21-25 find support at, e.g., page 10, lines 20-22 of the specification.

**Rejection Under 35 U.S.C. §103(a) Over Kuba**

Claims 1-11 and 13-20 are rejected under 35 U.S.C. §103(a) as being obvious over Kuba (U.S. Patent 5,806,072). Applicants traverse.

**The Present Invention And Its Advantages**

The present invention pertains to a novel file management method for copying real-time data stream files on rewritable discs that determines if a file name and/or directory change will render impossible the reproduction of real-time data files in the disk-recording medium (such as a DVD). The present invention finds a typical embodiment in instant claim 1, which sets forth:

1. A file managing method in reproducing a rewritable disk, comprising the steps of:
  - (a) checking the file names, directories, or names and directories of files written in the rewritable disk;
  - (b) providing a message indicating that reproduction is impossible when the file names, directories, or names and directories are against a

standard file scheme pre-specified for a disk containing real-time data; and

- (c) conducting a correction operation, if demanded.

The invention can further include the step of, before the step (a), inserting the rewritable disk containing real-time data stream files into a disk device.

As a result, the file managing method for real-time data file according to the present invention notifies a user of the reason why disk reproduction fails and corrects a wrong file scheme, if wanted, drawn up in a rewritable disk when a file containing real-time data stream is requested to be recorded, thereby preventing reproduction failure which would be caused from an inadequate file name or directory.

*Distinctions Of The Invention Over Kuba*

Kuba pertains to a hierarchical image data management technique for the static pictures of an electronic still camera (SMC). Kuba fails to teach a technology for reproducing a rewritable disk containing real-time audio or visual data.

At page 3 of the Office Action, the Examiner typically turns to the disclosure at column 27 of Kuba and asserts that this disclosure pertains a file managing method in reproducing a rewritable disc.

However, this disclosure pertains to the camera depicted in Figure 34, in which single electronic photographs are stored in a memory card 53. That is, the data of Kuba is not a data stream (as in the invention), but single frames.

The disclosure at column 27, lines 5-10 of Kubo refers to step S153 of Figure 39, which is labeled “Read Directory Entry Designated By Frame No.” As a result, the disclosure at column 27 of Kubo is specific to the reproduction of single frame (photograph) data stored in a memory card.

Similarly, the disclosure at column 51 of Kuba (used to reject independent claim 4) pertains to single frame data reproduction from a memory card of Figure 149, which has a simplified file management system that can include a simple serial counter S354.

In contrast, the present invention is drawn to the fundamentally different technology of the reproduction of a DVD disc containing a real-time data stream, such that claim 1 of the invention typically recites “a standard file scheme pre-specified for a disk containing real-time data.” Kuba, which pertains to static photographs stored on a memory card, utterly fails to disclose or suggest a technology pertaining to this type of real-time data stored on disc. Kuba additionally fails to disclose or suggest the step of inserting the rewritable disk containing real-time data stream files into a disk device (see claims 21-25).

Further, the Examiner uses the single reference of Kuba to allege *prima facie* obviousness. To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2143. In addition, if a reference needs to be modified to achieve the claimed invention “there must be a showing of a suggestion or

motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion." Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp., 225 F.3d 1349, 55 USPQ2d 1927 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In this case, the Examiner fails to point out where in the Kuba patent resides the teaching or suggestion to modify the technology to be applicable to rewritable discs containing real-time data. As a result, one having ordinary skill in the art would not be motivated by the teachings of Kuba to teach the invention embodied in independent claims 1, 4, 8, 13 and 15. A *prima facie* case of obviousness has thus not been made. Claims depending upon claims 1, 4, 8, 13 and 15 are patentable for at least the above reasons.

This rejection is accordingly overcome and withdrawal thereof is respectfully requested.

**Rejection Under 35 U.S.C. §103(a) Over Kuba And The Applicants' Disclosure**

Claim 12 is rejected under 35 U.S.C. §103(a) as being obvious over Kuba in view of the Applicants' disclosure. Applicants traverse.

The failures of Kuba in disclosing or suggesting the invention have been discussed above.

At page 8 of the Office Action, the Examiner asserts that Figure 9B of the application is admitted prior art. However no admission of prior art has been made by the Applicants. However, the Applicants respectfully note that using the Applicants' disclosure to allege prior art without an admission of prior art has been held to be improper. Riverwood International Corp. v. Jones & Co., Ltd., 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003).

Further, even if the Applicants' disclosure of the 1-byte field of Figure 9B of the invention could be combined with Kuba, this combination would fails to address the deficiencies of Kuba in suggesting a technology for applicable to rewritable discs containing real-time data. A *prima facie* case of obviousness has thus not been made.

This rejection is accordingly overcome and withdrawal thereof is respectfully requested.

**Prior Art Cited But Not Used By The Examiner**

The prior art cited but not used by the Examiner show the status of the conventional art that the invention supercedes. No additional remarks are accordingly necessary.

**CONCLUSION**

For the foregoing reasons and in view of the above clarifying amendments, Applicants respectfully request the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Registration No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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